

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Intermedia Advertising Group, Inc.
Serial No. : 76/092,228
Filed : July 19, 2000
Trademark : REWARDTV
Trademark Attorney : Ayisha Clarke
Law Office : 105



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Assistant Commissioner for Trademarks
United States Patent and Trademark Office
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Arlington, Virginia 22202-3513

APPELLANT'S REPLY BRIEF

Applicant, Intermedia Advertising Group, Inc. hereby replies to the Examining Attorney's Appeal Brief.

As established in Applicant's Appeal Brief, the mark REWARDTV is suggestive of Applicant's services, which consist of "business marketing and consulting services; conducting business research and surveys, promoting the sale of goods and services of others through promotional contests on the Internet; and providing a website which features advertisements for the goods and services of others on the Internet; and entertainment services, namely, providing an on-line computer game; entertainment services, namely providing information on-line about television programs."

“Whether a given mark is suggestive or merely descriptive depends on whether the mark ‘*immediately* conveys . . . knowledge of the ingredients, qualities, or characteristics of the goods . . . with which it is used’, or whether ‘imagination, thought, or perception is required to reach a conclusion on the nature of the goods.’ ” In re Gyulay, 3 U.S.P.Q.2d 1009, 1010 (CAFC 1987) quoting: In re Quik-Print Copy Shops, Inc., 205 U.S.P.Q. 505, 507 (CCPA 1980). [emphasis added]

The requirement that the conveyance be “immediate,” was omitted by the Examining Attorney both in her assertion of the test for determining descriptiveness and in her application of said test. It is not a feature of Applicant’s services that “viewers get rewards for watching television.”

To the contrary, Applicant conducts marketing and advertising services through its website that provides an on-line computer game. To play the game, consumers are required to watch specific television shows and *answer a series of questions* about the shows. They are awarded points for correct answers. The consumers can then redeem their points by entering sweepstakes to win prizes, which may not be related to TV, e.g. payment of an exorbitant phone bill, tickets to movie theaters, and gift cards for department stores.¹ Thus consumers are not rewarded for watching television, but rather, they are eligible to be rewarded for proper responses to trivia questions. As such, thought and perception are required to associate Applicant’s mark with features of Applicant’s services.

An analogous situation is On Technology’s application for the mark “AUDITTRACK” for “computer software for monitoring activity on a computer network,” which was refused under §2(e)(1) of the Trademark Act as being descriptive. The Board reversed said refusal. As

in the current case, the Examining Attorney submitted evidence that both “audit” and “track” were descriptive of characteristics of the software. After reviewing the evidence, the Board held:

“Applicant has created a word combination that is not readily recognizable as describing a particular characteristic of Applicant’s goods. There is no such thing as an ‘audit track’ nor is there any action that can be termed an ‘audit track.’ One would never say that a computer program performs an ‘audittrack or is capable of audittracking.’ Thus, the mark AUDITTRACK does not convey any immediate and unambiguous meaning.

In re On Technology Corporation, 41 U.S.P.Q.2d 1475, (TTAB 1996).

Similarly in the case at hand, Applicant has created a word combination that is not recognizable as describing a particular characteristic of Applicant’s services. There is no such thing as a “rewardtv” nor is there any action that can be termed a “rewardtv.” One would never say that Applicant’s business, consulting, or entertainment services are “rewardtv” or that they are “rewarding tv.” To the contrary, Applicant’s marketing and advertising services, which are conducted through its website via an on-line computer game, offer the possibility of rewards to consumers who correctly answer questions about specific television shows. This combination of descriptive words to form a suggestive mark is the same as On Technology’s use of the mark AUDITTRACK for software that audits a network to track network traffic. Thus, under the criteria set forth in the On Technology case, supra, the mark REWARD TV is suggestive, and not merely descriptive, of Applicant’s services.

Accordingly, as fully established both in Applicant’s Appeal Brief and above, the composite mark REWARDTV is suggestive of Applicant’s services since it is not readily recognizable as describing any particular quality, characteristic or feature of Applicant’s services; and since imagination, thought or perception is required to reach a conclusion about applicant’s services offered under the mark.

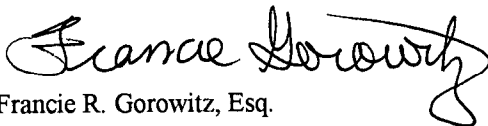
¹ Since June 2003 when Applicant’s Appeal Brief was filed, Applicant has expanded the ways for consumers to

Accordingly, it is respectfully requested that the refusal pursuant to §2(e)(1) of the Trademark Act, 15 U.S.C 1052(e)(1) be reversed.

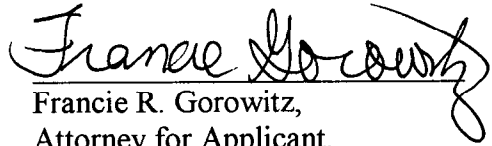
Date: September 24, 2003

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail addressed to Assistant Commissioner for Trademarks, United States Patent and Trademark Office, Box TTAB-NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3513 on September 24, 2003.


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Respectfully submitted,


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redeem their points and now allows consumers to bid on prizes or to submit a specific number of points for prizes.